



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,625	03/03/2000	Yoshinori Murata		5929

26021 7590 02/07/2005

HOGAN & HARTSON L.L.P.  
500 S. GRAND AVENUE  
SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/518,625

**Applicant(s)**

MURATA, YOSHINORI

**Examiner**

CHAN S PARK

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 8/13/04, and has been entered and made of record. Currently, **claims 1-20** are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1 and 12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 4, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al. U.S. Patent No. 5,892,587 (hereinafter Okada).

3. With respect to claim 1, Okada discloses a communication terminal device comprising:

document input means (communication control unit 41-3 in conjunction with facsimile control unit 41-4 in col. 8, lines 1-4) for obtaining an image comprising a plurality of pages to be transmitted (figs. 2 & 3);

image storage means (buffer) for storing at least a first page of the image obtained by the document input means (fig. 3);

communication control means (NCU 41-4) capable of communicating with a recipient over a communication line or network;

control means for causing the communication control means to automatically initiate dialing to the recipient when the first page of the plurality of pages of the image has been obtained from the document input means and stored in the image storage means (figs. 2 & 3 and col. 14, lines 54-57).

4. With respect to claim 4, Okada discloses the communication terminal device of claim 1 further including monitoring means for enabling a user to monitor the communication line or network (col. 5, lines 61-65 and col. 7, lines 47-48), and wherein the control means activates the monitoring means when the communication control means initiates dialing (col. 8, lines 10-12).

5. With respect to claim 12, arguments analogous to those presented for claim 1, are applicable.

6. With respect to claim 14, arguments analogous to those presented for claim 4, are applicable.

7. With respect to claim 15, Okada teaches the communication method of claim 12 further including the step of including information indicating that transmission is to be continued in a further communication in the transmission image (col. 12, lines 35-43).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claim 1 above, and further in view of Maniwa U.S. Patent No. 5,768,483.

8. With respect to claim 2, Okada discloses the communication terminal device of claim 1 wherein the control means checks whether or not an amount of space available in the image storage means falls within a predetermined value, after the communication control means has dialed the recipient (fig. 3 and col. 8, lines 27-31).

Okada, however, does not disclose expressly that the control means for indicating an incompletely stored page number to a user.

Maniwa, the same field of endeavor of the facsimile memory management art, discloses the communication terminal device (facsimile 102 in fig. 1) comprising:

image storage means (page buffer) for storing at least a first page of the image obtained by a scanner (col. 7, lines 51-55); and

communication control means (fax modem 108 in fig. 1) capable of communicating with a recipient over a communication line or network, wherein

control means for indicating an incompletely stored page number to a user when an amount of space available in the insufficiency of the memory occurs (col. 7, lines 51-55 and col. 32, lines 22-32).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the control means for indicating an incompletely stored page number to a user of Maniwa into the communication terminal device of Okada.

The suggestion/motivation for doing so would have been to notify/inform which pages are stored/unstored in the memory to the user when the insufficiency of the memory occurs.

Therefore, it would have been obvious to combine Okada with Maniwa to obtain the invention as specified in claim 2.

9. With respect to claim 3, Okada discloses the communication terminal device of claim 1 wherein the control means checks whether or not the image storage means becomes full, after the communication control means has dialed the recipient (fig. 3 and col. 8, lines 27-31).

Arguments analogous to those presented for claim 2, are applicable.

10. With respect to claim 5, Okada discloses the communication terminal device of claim 1 further including monitoring means for enabling a user to monitor the communication line or network (col. 5, lines 61-65 and col. 7, lines 47-48), and wherein the control means activates the monitoring means when the communication control means initiates dialing (col. 8, lines 10-12).

Art Unit: 2622

11. With respect to claim 6, arguments analogous to those presented for claim 5, are applicable.

12. With respect to claim 7, Okada discloses the communication terminal device wherein information indicating that the transmission is to be continued in a further communication is included in the transmission image (col. 12, lines 35-43).

13. With respect to claim 8, arguments analogous to those presented for claim 7, are applicable.

14. With respect to claim 9, Okada discloses the communication terminal device of claim 1 wherein the control means checks whether or not the image storage means becomes full, after the communication control means has dialed the recipient (fig. 3 and col. 8, lines 27-31).

Okada, however, does not disclose expressly that the device informs the user if one page of an image cannot be stored.

Maniwa, as noted in the arguments presented for claims 2 and 3, discloses the communication terminal device wherein if one page of an image cannot be stored, the device informs the user of this fact (col. 7, lines 51-55 and col. 32, lines 22-32).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the control means for indicating/informing the fact that one page of an image cannot be stored of Maniwa into the communication terminal device of Okada.

The suggestion/motivation for doing so would have been to notify/inform which pages are stored/unstored in the memory to the user when the insufficiency of the memory occurs.

Therefore, it would have been obvious to combine Okada with Maniwa to obtain the invention as specified in claim 9.

15. With respect to claim 10, Maniwa discloses the communication terminal device wherein when the device informs the user, the device suggests an alternative transmission method (rescanning of the unsaved pages in col. 32, lines 22-32).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the control means for indicating/informing the fact that one page of an image cannot be stored of Maniwa into the communication terminal device of Okada.

The suggestion/motivation for doing so would have been to notify/inform which pages are stored/unstored in the memory to the user so that user can obtain and transmit the remaining pages to the destination.

Therefore, it would have been obvious to combine Okada with Maniwa to obtain the invention as specified in claim 10.

Claim 13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claim 12 above, and further in view of Maniwa.

16. With respect to claim 13, arguments analogous to those presented for claim 2, are applicable.



Art Unit: 2622

17. With respect to claim 16, arguments analogous to those presented for claim 7, are applicable.

18. With respect to claim 17, arguments analogous to those presented for claims 9 and 10, are applicable.

19. With respect to claim 18, arguments analogous to those presented for claims 9 and 10, are applicable.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claim 1 above, and further in view of Ochiai U.S. Patent No. 5,457,544.

20. With respect to claim 11, Okada discloses the communication terminal device of claim 1, but it does not disclose expressly that scanning of pages (at the originator fax 20a) and transmission are performed simultaneously starting from the second page of the document.

Ochiai discloses a facsimile apparatus comprising a scanner for scanning a plurality of pages (figs. 1-3).

Okada & Ochiai are combinable because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the facsimile apparatus of Ochiai as the transmitting fax 20a of Okada.

The suggestion/motivation for doing so would have been improve the overall facsimile transmission from the time of the scanning to the receiving of the image data.

Note that, by combining the two references, it would have been obvious to one of ordinary skill in the art to recognize that scanning (scanning of the second page at the transmitting fax 20a) and transmitting (transmitting of data from fax mail apparatus 40 to receiving fax 20b) are performed simultaneously starting from the second page of the document. It would have been obvious since scanning and transmitting at the transmitting fax 20a performs simultaneously (fig. 3 of Ochiai) and transmitting (fig. 15 of Okada) to receiving fax 20b performs when the fax mail apparatus 40 receives the first page.

Therefore, it would have been obvious to combine Okada with Ochida to obtain the invention as specified in claim 11.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claim 12 above, and further in view of Ochiai.

21. With respect to claim 19, arguments analogous to those presented for claim 11, are applicable.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Okada and Maniwa as applied to claim 13 above, and further in view of Ochiai.

22. With respect to claim 20, the combination of Okada and Maniwa does not teach expressly that scanning and transmission are performed simultaneously starting from a second page of the document.

Ochiai discloses a facsimile apparatus comprising a scanner for scanning a plurality of pages (figs. 1-3).

Okada, Maniwa & Ochiai are combinable because they are from the same field of endeavor that is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the facsimile apparatus of Ochiai as the transmitting fax 20a of Okada.

The suggestion/motivation for doing so would have been improve the overall facsimile transmission from the time of the scanning to the receiving of the image data.

Note that, by combining the two references, it would have been obvious to one of ordinary skill in the art to recognize that scanning (scanning of the second page at the transmitting fax 20a) and transmitting (transmitting of data from fax mail apparatus 40 to receiving fax 20b) are performed simultaneously starting from the second page of the document. It would have been obvious since scanning and transmitting at the transmitting fax 20a performs simultaneously (fig. 3 of Ochiai) and transmitting (fig. 15 of Okada) to receiving fax 20b performs when the fax mail apparatus 40 receives the first page.

Therefore, it would have been obvious to combine Okada and Maniwa with Ochiai to obtain the invention as specified in claim 20.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishizuka et al. U.S. Patent No. 5,282,050 (hereinafter Ishizuka).

23. With respect to claim 1, Ishizuka discloses a communication terminal device (facsimile device 1 in fig. 1) comprising:

document input means (reader unit 2) for obtaining an image comprising a plurality of pages to be transmitted;

image storage means for storing at least a first page of the image obtained by the document input means;

communication control means (communication control 5) capable of communicating with a recipient over a communication line or network;

control means for causing the communication control means to automatically initiate dialing to the recipient when the first page (first original including the first page) of the plurality of pages of the image has been obtained from the document input means and stored in the image storage means (S13 in fig. 2).

It should be noted that the data transmission starts after the reading and dialing to the recipient is an inherent/required step in the facsimile communication. Also, it is noted that the image storage means is an inherent feature in the facsimile apparatus (col. 3, lines 37-43).

24. With respect to claim 12, arguments analogous to those presented for claim 1, are applicable.

***Conclusion***

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
January 27, 2005

Chan S. Park  
Examiner  
Art Unit 2622

  
EDWARD COLES  
SUPERVISOR  
TECHNOLOGY CENTER 2000